



Express Mail Mailing Label No. EV446919731

Docket No.: 7334/8
Serial No.: 09/222,336
Filed: December 28, 1998

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : STORY et al.
Serial No. : 09/222,336
Filed : December 28, 1998
Group Art Unit : 3622
Confirmation No. : 3308
Examiner : RETTA, Yehdega
Title : LICENSE MANAGEMENT FOR DIGITAL CONTENT

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request review of the final rejection set forth in the Office Action dated August 11, 2005. The review is requested for at least the reasons set forth in the Remarks beginning on page 2 of this paper. No amendments are presented with this Request. A Notice of Appeal and a Petition for Extension of Time are filed concurrently herewith. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 02-4270.

REMARKS

I. Introduction

Claims 1-8, 10-18, and 20-36 are pending in this application.

Claims 1-8, 10-18, and 20-36 are rejected.

For at least the reasons set forth below, applicants traverse, and respectfully request review of, these rejections.

II. Applicants' Reply to Claim Rejections Under 35 U.S.C. § 112

Claims 1-8, 10-18, and 20-36 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse.

Independent claims 1, 11, 21, 24, 31, and 34 specify creating a license comprising a cardinality that indicates the number of playback devices that can be authorized for playback of associated digital audio content. The Examiner contends that “the specification does not teach the ‘license comprising of [sic] cardinality.’”¹ *See* Office Action dated August 11, 2005, at page 3. Applicants respectfully disagree. The specification as filed fully supports the phrase “comprising” and the language of the pending claims, including “creating a first license comprising a first cardinality, wherein a cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content.” *See, e.g.*, Application, page 5, lines 14-16, 21-22; page 11, lines 10-11, 15-17 (the transitional phrase “having” used in the specification supports the transitional phrase “comprising”). Although applicants believe this claim language is fully supported by the current specification, further additional support can be

found in the originally filed claims, which are attached herewith as Exhibit A for the convenience of the Examiners. For example, claim 1 recites “creating a first license having a first cardinality.” See Ex. A. Applicants will amend the specification to include the claim language, if the Examiner deems such an amendment necessary. *See, e.g.*, MPEP 608.01 (I). No new matter has been added. Accordingly, applicants respectfully request that the rejection pursuant to under 35 U.S.C. §112, first paragraph, be withdrawn.

III. Applicants’ Reply to Claim Rejections Under 35 U.S.C. § 102

Claims 1-8, 10-18, and 20-36 are rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Pat. No. 5,926,624 to Katz et al. (“Katz”). Applicants respectfully traverse.

As specified in independent claims 1, 11, 21, and 34, the applicants’ claimed invention describes methods and apparatuses including transmitting information corresponding to the first license to a content provider from the license management device. The Examiner points to a single passage in Katz as disclosing this feature. *See* Office Action dated August 11, 2005, at page 5.

In fact, the passage cited by the Examiner states:

“The digital information library is an indexed collection of digital information programming, drawing content from digital information sources such as books, daily news and entertainment feeds, conferences and educational sources, other computer systems, the host on the World Wide Web (WWW) of the Internet, and customized audio or visual image programming. Other sources of the digital information content include, but are not limited to, conference or seminar proceedings, lecture or speech materials, language lessons, readings, comedy, customized spoken digests and related, “need-to-know” business information, computer software, local sound studio material, text to speech conversion of machine readable files, pre-recorded material from magnetic tape, CD-ROM, digital audio

¹ Applicants note that the Examiner inadvertently uses the phrase “comprising of” rather than “comprise.”

tape, or analog cassette tape. This digital information content is input as raw digital information content to authoring system 280 shown in FIG. 2. In an alternative embodiment, a raw digital information digitizer 307 is included for receiving raw input and converting the input to a digital form which can be manipulated as a digital information file.”

See Katz at column 5, lines 45-65. This passage discloses, among other things, various sources of digital information rather than the transmission of the information corresponding to the first license to a content provider from the license management device, as specified in independent claims 1, 11, 21, and 34. Thus, claims 1, 11, 21, and 34, and claims dependent therefrom, are patentable over Katz.

Furthermore, independent claims 1, 11, 21, 24, 31, and 34 specify that a cardinality indicates the number of playback devices that can be authorized for playback of digital content. Previously, the Examiner agreed that the Group ID in Katz does not indicate the number of playback devices in the group. *See* Office Action dated February 24, 2005, at page 5.

Now the Examiner contends that Katz does show this feature of the applicants’ claimed invention because “[p]layers with the same Group ID, indicates [sic] the number of playback devices that are authorized to play the content (cardinality).” Applicants respectfully disagree. First, cardinality specifies the number of licensed playback devices whereas content represents information consumed by the devices, and are therefore not the same, as the Examiner contends.

Second, targeting a specified set of mobile playback devices using a Group ID as described in Katz is not the same as using a cardinality indicating a number of playback devices that can be authorized for playback of digital content because a Group ID does not specifies the number of licensed playback devices whereas a cardinality does.

Thus, applicants submit that Katz fails to teach or suggest every element of independent claims 1, 11, 21, 24, 31, and 34. Dependent claims 2-8, 10, 12-18, 20, 22, 23, 25-30, 32-33, 35, and 36 are separately patentable over Katz for at least the same reasons. Accordingly, for at least the foregoing reasons, applicants submit that a *prima facie* case of anticipation has not been established, and thus the rejection of claims 1-8, 10-18, and 20-36 under 35 U.S.C. §102(e) should be withdrawn.

IV. Conclusion

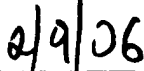
For the foregoing reasons, applicants respectfully submit that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 1-8, 10-18, and 20-36 are respectfully requested. The Pre-Appeal Brief Panel of Examiners consideration of this request is gratefully acknowledged. To expedite prosecution, the Examiners are invited to contact applicants' undersigned representative at the number indicated below.

Dated: February 9, 2006

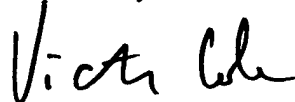
I hereby certify that the correspondence attached herewith is being deposited this date with the U.S. Postal Service as Express Mail Mailing Label No. EV446919731, with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.



Victor Cole


Date

Respectfully submitted,



Victor Cole
Reg. No. 56,331
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Tel : (212) 895-2058
Fax: (212) 895-2900